

Docket No. 740756-2659

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No. 9428
Shunpei YAMAZAKI et al.)
Serial No. 10/678,139) Examiner: Maria F. Guerrero
Filed: October 6, 2003) Group Art Unit: 2822
For: METHOD FOR FABRICATING)
SEMICONDUCTOR THIN FILM) Date: March 29, 2006

RESPONSE AND SUBMISSION OF TERMINAL DISCLAIMER

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Action mailed December 6, 2005, has been received and carefully reviewed. Applicants respond as follows:

On page 3 of the Office Action, claims 7 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6,686,262; claims 22, 23 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-10, 17, 18, 24, 25 and 29 of U.S. Patent No. 6,048,758; and claims 7, 8, 10-13, 15-18 and 20-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 7, 27, 28, 32, 33, 36, 37, 40 and 41 of U.S. Patent No. 6,331,457.

In response to these rejections, Applicants hereby submit a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c) with respect to U.S. Patent Nos. 6,686,262, 6,048,758, and 6,331,457. It is respectfully submitted that all pending double patenting rejections are overcome by this submission.

With reference to Patent Rule 1.175 and MPEP Section 1414, the Office asserts that

the declaration filed with the present application is defective because "[t]he filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application." (See, page 4, section 9 of the Action.) It is respectfully submitted, however, that it is not necessary to file a new declaration under 37 C.F.R. 1.175 (a)(1). Rather, it is believed that only a "supplemental declaration" under 37 C.F.R. 1.175 (b)(1) would be required before allowance of the present application.

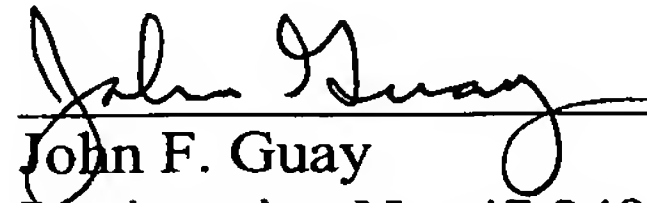
While 37 C.F.R. 1.175 (e), which concerns reissue oath or declaration in a "continuing" reissue application (i.e., an application that replaces its parent reissue application), requires identification of at least one error in the original patent not corrected by the patent reissue application, section 1414(II)(D) of the Manual of Patent Examination Procedure (MPEP) distinguishes between "continuation" and "divisional" reissue applications, and states that a new declaration may not be necessary in a divisional reissue if the error identified in the original reissue declaration is still being corrected. Applicants respectfully assert that the error identified in the parent reissue application declaration is still being corrected in the present application, and that a copy of this declaration was submitted in the present divisional reissue application. Accordingly, it is believed only a "supplemental declaration" under 37 C.F.R. 1.175 (b)(1) would be required in the present application to fully comply with Rule 1.175.

The Action also includes a rejection of claims 7-37 under 35 U.S.C. 251 as being based upon a defective reissue oath/declaration. In the statements of the rejection, the Office indicates that receipt of an appropriate supplemental oath/declaration under 37 C.F.R. 1.175(b)(1) would overcome the rejection under 35 U.S.C. 251. In response, Applicants are preparing a supplemental declaration under 37 C.F.R. 1.175(b)(1). Applicants believe a supplemental declaration will be executed and thereafter filed in the Patent Office within about two months. It is respectfully requested that the Office hold the rejection under 35 U.S.C. 251 in abeyance until the supplemental declaration is submitted.

In view of the foregoing, it is respectfully requested that the rejections of record be reconsidered and withdrawn, and that claims 7-37 are allowed, or if the Office issues another action prior to Applicants' submission of a supplemental oath/declaration, that the Examiner

indicate the application would be allowed subject to Applicants' submission of a supplemental oath/declaration. If a conference would expedite prosecution of the instant application, the Examiner is hereby invited to telephone the undersigned to arrange such a conference.

Respectfully submitted,


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Registration No. 47,248

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Filed: October 6, 2003) Examiner: GUERRERO
For: METHOD FOR FABRICATING SEMICONDUCTOR THIN FILM)

TERMINAL DISCLAIMER

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

I, Dr. Shunpei Yamazaki, having a place of business at Semiconductor Energy Laboratory Co., Ltd., 398, Hase, Atsugi-shi, Kanagawa-ken 243-0036 Japan, state that I am authorized to sign on behalf of the assignee of this invention and that the Assignment referred to below has been reviewed and certify that, to the best of my knowledge and belief, the entire right, title and interest in the above-identified application is in the name of Semiconductor Energy Laboratory Co., Ltd. by virtue of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 07701, Frame 0233-0225.

Semiconductor Energy Laboratory Co., Ltd. hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,686,262, Patent No. 6,048,758, and Patent No. 6,331,457.

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Semiconductor Energy Laboratory Co., Ltd. hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and prior Patent No. 6,686,262, Patent No. 6,048,758, and Patent No. 6,331,457 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Semiconductor Energy Laboratory Co., Ltd. does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 35 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

09/20/2006

Date

Shunpei Yamazaki

Name: Shunpei Yamazaki

Title: President

Company Name: Semiconductor Energy Laboratory Co., Ltd.